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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ES-5506-4
Confirmation No. 8959

Application Number

10/500,332

Filed

July 21, 2004

First Named Inventor

ANCOROTTI, R

Art Unit

1615

Examiner

Ahmed

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

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(Reg. No.)

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Registration number if acting under 37 C.F.R. § 1.34 _____



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August 18, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

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STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

There is only one rejection. Claims 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42 and 43 stand rejected under 35 U.S.C. 103 as allegedly obvious in view of Verdon (U.S. Patent 4,994,264). The Final Rejection includes the following error:

The Final Office Action contains a clear error because it failed to allege that a claim limitation of a “non-pressed powder” is anticipate and/or obvious in view of the prior art. Since the Final Office Action has ignored this limitation, a prima facie case of obviousness has not been established and the rejection is improper.

Appellants claimed invention relates to non-pressed powders only. There are four independent claims currently pending - claims 18, 29, 42 and 43. Each of the independent claim relates to, inter alia, “a process for the preparation of a non-press powder make-up cosmetic.” Further, in the claimed processes, each claim recites, inter alia, “to obtain a dried non-pressed powder of a solid consistency.”

In contrast, the only cited reference Verdon relates to pressed powder only. The fact that Verdon relates to pressed powder only may be seen throughout Verdon’s specification. See, e.g., Verdon’s title, Abstract, Summary of the Invention, Detailed Description of the Preferred Embodiments, Examples, and Claims. Even in Verdon’s section entitled “Background of the Invention”, only prior art related to compressed powders are presented. In fact, Verdon does not contain a single reference which relates to its invention as a non-pressed powder or suitable for

use as a non-pressed powder.

One of ordinary skill in the art would recognize that non-pressed powder and pressed powder are significantly different from each other. Non-pressed powders are more loose, softer and easier to blend with other makeup such as foundations. Naturally, since non-pressed powder are not pressed or molded, they are more easily useable in loose form and disperse more easily for a more even look when used as makeup (i.e., there is less clumping of the powder after application).

Pressed powders are not as loose as non-pressed powder and, because of emollients and binders used to keep the powder in a solid form, may have difficulties in being removed (e.g., from a compact) in powder form for use, for example, on a face. This difficulty is especially acute if the pressed powder is stored incorrectly in heat or humid conditions which can further increase the binding of the powder in cake form. Because pressed powder is a different and distinct product, some users feel that pressed powder have a shine and texture that is distinct from non-pressed powder.

There are significant physical and chemical differences between a pressed powder and a non-pressed powder. A pressed powder cosmetic composition such as foundation, face powder or eye shadow is usually prepared by press molding, that is, solidification of a raw material composition, which has been filled in a container, by compression. If a conventionally-employed pressed powder cosmetic composition contains an oil in a relatively small amount, a high molding pressure is required in order to overcome its weak powder-to-powder binding power. The press-molded product thus obtained is usually very hard and lacks soft touch feeling and does not easily become detached from the cake of pressed powder for use as makeup (poor

payout). Further, even if pressed powder becomes freed from the pressed cake, it may not easily attach to an applicator or not easily become a free powder for an even coverage of, for example, a face without caking and inhomogeneous distribution (poor spreadability). On the other hand, pressed powders with more binders (such as wax) are easier to press but, like powders pressed under high pressure, such products would suffer from the same disadvantages of not being easily detached from the cake and poor spreadability. If the binder or the pressure during molding is insufficient, the pressed powder would have lowered strength of the final product or lowered stabilities, including shape retention, over time.

One of ordinary skill in the art would know that non-pressed powder suffers none of the above disadvantages of pressed powder. Since there is no physical requirement for the powder to form cakes upon pressing, non-pressed powder can have different compositions and chemistry (e.g., less oil, less binders, less emollients) than pressed powders.

Significantly, the Examiner has not provided any reference that discloses or renders obvious Appellants' claim limitation of a "non-pressed powder." Furthermore, the Examiner has not asserted that the pressed powder of Verdon to be the equivalent of the claimed non-pressed powder. The final Office Action is silent with respect to the claim limitation of a "non-pressed powder" and has not even alleged an equivalence of pressed and non-pressed powders based on common knowledge.

Since the final Office Action has not addressed at least one claim limitation, the final Office Action has a clear error and has not made a prima facie case of obviousness.

For the reasons stated above, the Final Rejection should be withdrawn and the Application passed to allowance.